

REMARKS

I. Status and Disposition of the Claims

Claims 1-23, 27, 32-35, 38-40, 46, 63-65, 80-86, 90 and 91 are pending and stand rejected. Claims 27, 32, 38, 39 and 79 are canceled herein without prejudice or disclaimer. Claims 1, 33, 40, 63, 64, 66, 72, 75, 87, 92, and 93 are amended herein. Support for the amendment to claims 1, 87, 92 and 93 can be found, for example, at paragraph [070] of the as-filed specification. Claims 33, 40, 63, 66, 72, 75, and 87 are amended in order to maintain antecedent basis following the amendment of claim 1 and to correct grammar.

II. Rejection of Claims under 35 U.S.C. § 112

The Office rejects claims 1-23, 27, 32-35, 38-40, 46, 63-65, 79-86, and 90-91 under 35 U.S.C. § 112 as lacking adequate written description support. *Office Action* at page 2. The Office's position appears to be that, because the elected species is "ethyl acrylate/styrene/methacrylic acid," ethyl acrylate must correspond to the first monomeric residue recited in amended claim 1, styrene must correspond to the second monomeric residue, and methacrylic acid must correspond to the third monomeric residue. Thus, when applied to the elected species, the Office alleges that amended claim 1 must essentially read: "A hair-cosmetic composition comprising...at least one film-forming gradient copolymer containing from 5 to 25 percent by weight of ethyl acrylate, from 5 to 25 percent by weight of styrene and from 50 to 90 percent by weight of methacrylic acid."

Based on that interpretation, the Office asserts that claim 1 does not have adequate written description support, and does not cover the elected species. First, the Office alleges that the limitation "containing from 5 to 25 percent by weight of a first monomeric residue" is not supported by the specification because ethyl acrylate, which the Office alleges must be the first monomeric residue, is a monomer described in the specification as having a Tg less than 20 C, and because the specification further states that such monomers may be present in an amount ranging from 50 to 90 percent by weight. Second, the Office alleges that the limitation "containing from 50 to 90 percent by weight of a third monomeric residue" is not supported by the specification because the specification describes methacrylic acid, which the Office alleges must be the third monomeric residue, as a hydrophilic monomer, and because the specification further describes such monomers as being present in an amount ranging from 5 to 25 percent.

Applicant respectfully disagrees with the Office's position and traverses the rejection for at least the following reasons.

First, Applicant asserts that the previously submitted Claim 1 does cover the elected species. In particular, nothing required the first, second and third monomeric residues recited in the previously submitted claim to correlate with the first, second and third listed monomer in the elected species respectively. Thus, the previously submitted Claim 1 covered the elected species when, for example, the first monomeric residue was chosen to be styrene, the second monomeric residue was chosen to be methacrylic acid, and the third monomeric residue was chosen to be ethyl acrylate.

Nonetheless, for the sole purpose of advancing prosecution, Applicant herein amends Claim 1 to address the concerns raised by the Office. As currently amended,

Claim 1 requires “at least one film-forming gradient copolymer containing from 5 to 25 percent by weight of a hydrophilic monomeric residue.” As noted by the Office, the specification describes methacrylic acid as a hydrophilic monomer, and further explains that hydrophilic monomers may be present in amounts ranging from 5 to 25 percent by weight. *See* Office Action at page 3. Thus, methacrylic acid may be chosen as the hydrophilic monomeric residue

Claim 1, as currently amended, also requires the gradient copolymer to comprise “from 50 to 90 percent by weight of a monomeric residue with a Tg less than or equal to 20 C.” As noted by the Office, ethyl acrylate is described in the specification as a monomer having a Tg less than or equal to 20 C, and the specification further states that monomers having a Tg less than or equal to 20 C may be present in an amount ranging from 50 to 90 percent by weight. *See* Office Action at pages 3-4. Thus, ethyl acrylate may be chosen as the monomeric residue with a Tg less than or equal to 20 C.

Finally, currently amended Claim 1 requires that the gradient copolymer comprise from “5 to 25 percent by weight of an additional monomeric residue.” Nothing in the instant specification would prevent the selection of styrene as this additional monomer. Thus, currently amended Claim 1 covers the elected species when methacrylic acid is chosen as the hydrophilic monomeric residue, ethyl acrylate is chosen as the monomeric residue having a Tg less than or equal to 20 C, and styrene is chosen as the additional monomeric residue.

Because the currently amended claims cover the elected species, Applicant respectfully request that the rejection under § 112 be withdrawn.

III. Provisional Non-Statutory Double Patenting Rejection

Claims 1-23, 27, 32-35, 38-40, 46, 63-65, 79-86, 90 and 91 are provisionally rejected for non-statutory obviousness-type double patenting over various allowed claims of Application No. 10/734,301 ("the '301 application"). In light of the Terminal Disclaimer concurrently filed by Applicant, this rejection is now moot. Applicant therefore respectfully requests the withdrawal of this rejection.

IV. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 16, 2009

By: W Li
Wen Li
Reg. No. 62,185 for

Lauren L. Stevens
Reg. No. 36,691

Tel: (650) 849-6614
Email: lauren.stevens@finnegan.com